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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,808	08/24/2000	Roland Fischer	F-6485	9821
7590 06/28/2006			EXAMINER	
Jordan & Hamburg 122 East 42nd Street New York, NY 10168			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/509,808

Applicant(s)

FISCHER ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 32-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed April 11, 2006.

Claim 24 was amended rendering claims 24-28 and 30-31 pending with claims 32-46 withdrawn as a non-elected invention.

### ***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Hashimoto (U.S. 5,485,685).

Hashimoto discloses a wood block, where the lignin in the wood structure is melted which firmly blocks the cellulose and hemicellulose composing the cells of the wood (column 4, lines 5-8 and lines 58-61) and the oil and fat components of wood are melted (column 6, lines 1-5). The melted lignin in the wood's cell structure ensures the coloring of the wood with a dye that can penetrate deep into the wood's interior (column 5, lines 1-7) where the melted lignin of the wood is physically altered from its original state. In instant claim 24, the phrase, "being created by exposure of at least a portion of

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the article of wood to an increased temperature which raises the wood comprising said at least a portion of the article of wood above a melting point thereof" introduces a process limitation to the product claim. Additionally, in instant claim 25, the phrase "cell walls melted in one or several cutting directions" also introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. In claim 24, the phrase, "caused by short time high energy input into the wood component resulting from electromagnetic waves in the form of laser light having a duration of up to 50ms" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Hashimoto is silent as to the wood melts being free from pyrolytic degradation as per instant claim 24. Since no such degradation is disclosed as being present, the limitation of claim 24 is met. Although Hashimoto does not explicitly disclose the melted areas having a higher hardness and abrasion resistance than the non-melted wood as in instant claim 27 or the wood melts having a low degree of polymerization and increased plasticization compared to the original state of the wood as in instant claim 24, these claimed features are directly related to the melted wood parts. Since Hashimoto teaches the same components as Applicant, these features would be expected, absent any evidence to the contrary.

***Claim Rejections – 35 USC § 103(a)***

4. Claims 24-28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Hashimoto (U.S. 5,784,805).

Hashimoto discloses a wood block, where the lignin in the wood structure is melted which firmly blocks the cellulose and hemicellulose composing the cells of the wood (column 4, lines 5-9 and lines 59-61) and the oil and fat components of wood are melted (column 6, lines 1-5). The melted lignin in the wood's cell structure ensures the coloring of the wood with a dye that can penetrate deep into the wood's interior (column 5, lines 1-9) where the melted lignin of the wood is physically altered from its original state. In instant claim 24, the phrase, "being created by exposure of at least a portion of the article of wood to an increased temperature which raises the wood comprising said at least a portion of the article of wood above a melting point thereof" introduces a process limitation to the product claim. Additionally, in instant claim 25, the phrase, "cell walls melted in one or several cutting directions" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. In claim 24, the phrase, "caused by short time high energy input into the wood component resulting from electromagnetic waves in the form of laser light having a duration of up to

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50ms" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Hashimoto is silent as to the wood melts being free from pyrolytic degradation as per instant claim 24. Since no such degradation is disclosed as being present, the limitation of claim 24 is met. Although Hashimoto does not explicitly disclose the melted areas having a higher hardness and abrasion resistance than the non-melted wood as in instant claim 27 or the wood melts having a low degree of polymerization and increased plasticization compared to the original state of the wood as in instant claim 24, these claimed features are directly related to the melted wood parts. Since Hashimoto teaches the same components as Applicant, these features would be expected, absent any evidence to the contrary.

### ***Response to Arguments***

5. Rejection made under 35 USC 112, first paragraph is withdrawn due to Applicant showing support for the claim language indicated in the rejection.

Rejection made under 35 USC 103(a) as being unpatentable over Hashimoto (U.S. 5,485,685) and Hashimoto (U.S. 5,784,805) have been considered but is unpersuasive. Applicant argues the method steps of the present Application distinguish it from the prior art. Examiner maintains the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227

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USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Applicant further argues the wood of Hashimoto patents maintain their basic structure. Examiner is not persuaded by this argument and maintains that Hashimoto discloses a wood block, where the lignin in the wood structure is melted (column 4, lines 5-8 and lines 58-61) and the oil and fat components of wood are melted (column 6, lines 1-5). Applicant further argues the wood of Hashimoto does not exhibit a low degree of polymerization and increased plasticization compared to the original state of the wood. Since Hashimoto teaches the same components as Applicant, these features would be expected, absent any evidence to the contrary.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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